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20735/US**REMARKS*****Amendment to the Claims***

The applicants would like to thank the Examiner for meeting with the applicants' representative for the interview of 17 August 2004. While it appears there was not complete agreement with all of the issues, the discussion was able to move prosecution forward with regard to consideration of the draft claim presented at the interview.

In order to expedite prosecution, the substance of the draft claim discussed has been inserted into claims 1 and 12-16. Support for this limitation can be found e.g. on pages 22-25 of the specification (see Examples 7 and 8). Claims 1-18 are still pending. It is believed that no new matter has been added.

***35 U.S.C. 102(b) rejections***

- (1) Claims 1-4, 8, 9, 12-16 and 18 were rejected as being anticipated by Dorsky et al. (U.S. Patent 3,499,937).
- (2) Claims 1-4, 12-16 and 18 were rejected as being anticipated by Darsow (U.S. Patent 5,874,648).
- (3) Claims 1-4, 12-16 and 18 were rejected as being anticipated by Hall et al. (U.S. Patent 4,104,203).

***35 U.S.C. 103(a) rejections***

Claims 1-18 were rejected as being obvious over Dorsky et al., Darsow and hall, *id.* further in view of Robinson.

***Response to rejections***

It is believed that the amendment to the claims renders the previous art rejections moot, but the applicants offer the following comments to remind the Examiner about the substance of the discussion during the interview.

The compounds used in the applicants' invention had been known in the prior art as being a side product in the production of other odor/perfume compounds (e.g. compounds with sandalwood odor, sandela) which was reflected in the prior art cited by the Examiner. However, it was unknown that these side products had any utility as an anti-bacterial agent and there was never any indication of interest in

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isolating the products currently used in the applicants' invention, especially since the compounds in the applicants' claims are odorless and thus would have been of little interest to one of ordinary skill in the art seeking to replicate sandalwood odor.

Surprisingly, the applicants' found that when isolating the various compounds present in sandela, the compounds described in the claims (fraction 16) had unexpectedly superior anti-bacterial activity compared with the other components of sandela and the next best fraction, fraction 15 (see Table 6, page 23 of the specification). Even within fraction 16, specific compounds within this fraction showed superior anti-bacterial properties over sandela as a whole (see Table 7, page 25 of the specification - the compounds of Peaks A, B and C are the compounds cited in the claims).

In addition, the Examiner and the applicants' representative agreed to use the transitional term "consisting essentially of" as this helps to distinguish the invention over generic teachings such as Dorsky et al. which merely make tangential reference to the compounds used in the applicants' claims. i.e. additional ingredients can be added as long as they do not materially affect the basic and novel properties of the invention. As shown in the applicants' Tables of data, adding similar compounds greatly decreases the efficacy of anti-bacterial activity if the mixture of compounds taught by Dorsky is used and there is insufficient direction to isolate the specific compounds claimed by the applicants because the compounds in question are odorless and have previously unknown superior anti-bacterial activity.

For these reasons, even if the claimed compounds were generically known, one of ordinary skill in the art would not have been directed to select the compounds used by the applicants nor would they have expected the degree of anti-bacterial activity displayed by the applicants and therefore, the claims as amended are non-obvious over the prior art.

#### **Closing**

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

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**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 (10 pages) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 5 August 2004

By: \_\_\_\_\_

*Agata Glinska*  
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